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IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

GILBERT P. HYATT,
Petitioner,
v.
GARY W. BOONE,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

The petition in this case rested, in large part, on a simple point: that Section 112, ¶ 1 of the Patent Act contains only one written description requirement, not two. In particular, we argued that the second written description requirement created by the court of appeals—that the specification contain a written description showing "possession of the invention"—was an unfounded addition to the traditional requirement of a written description sufficient to enable the making and using of the invention. This second requirement not only finds no warrant in the language of the statute, but is contrary to the basic understanding, recently reaffirmed by this Court (*see Pfaff v. Wells Electronics, Inc.*, 119 S. Ct. 304, 311-12 (1998)), that a description allowing the practice of an invention demonstrates that the inventor has fully conceived of that invention. The possession-of-the-invention requirement thus adds a needless element of confusion and uncertainty

to the patenting process, without serving any interest not already served by proper application of the enablement requirement.

Faced with these arguments, respondent takes several unusual tacks. Most notably, he seeks to defend the second written description requirement on a ground—that it is necessary to show that the invention is an advance over prior art—that has never even been mentioned, much less relied upon, by the Federal Circuit itself. To make matters worse, he then suggests that the written description in a specification must serve this role, instead of the patent *claims*, despite the fact that the relevant statutory history (this purpose for the description was eliminated in 1836) and the uniform weight of authority are to the contrary. The result is utter confusion: what appears on its face to be a straightforward requirement for the written description of an invention, that it enable the making and using of that invention, has now been stretched to encompass a possession-of-the-invention requirement that was never in the statute at all and a distinguish-the invention-from-prior-art requirement that was dropped from the statute more than 160 years ago (as that role was assumed by the patent claims).

The same misconception by respondent guides his erroneous reading of *Pfaff* as well. While it is true that the "on-sale bar" at issue in *Pfaff* "does not concern itself with distinctions over prior art" (Br. in Opp. 22), neither does the written description requirement of Section 112, ¶ 1. What they do concern, however, is the point at which an inventor is deemed to have a complete conception of his invention. This Court stated clearly in *Pfaff* that an invention is "complete and ready for patenting" (119 S. Ct. at 311) at the point that the inventor has prepared a description "sufficiently specific to enable a person skilled in the art to practice the invention." 119 S. Ct. at 312. If that is so, then it follows that an enabling description in a patent specification is enough to show that an inventor has completely conceived of his invention at that time.

An additional "possession-of-the-invention" requirement thus serves only to erect a further arbitrary barrier to the patenting process without any legitimate purpose.

1. Although respondent concedes that the question of the standards to be applied to the possession-of-the-invention requirement is properly before the Court, he argues that the underlying issue of the validity of the requirement itself is not. Br. in Opp. 13-16. But, in pressing this argument, respondent ignores the decisions of this Court clearly holding that it (or other federal courts) may "consider an issue 'antecedent to . . . and ultimately dispositive of' the dispute before it, even an issue the parties fail to identify and brief." *United States National Bank of Oregon v. Independent Ins. Agents of America, Inc.*, 508 U.S. 439, 447 (1993) (quoting *Arcadia v. Ohio Power Co.*, 498 U.S. 73, 77 (1990)). *See Missouri v. Jenkins*, 515 U.S. 70, 84-85 (1995) (addressing "an issue subsidiary to our ultimate inquiry"). Likewise, the Court has considered arguments, even though not previously raised by the parties, where the issues were nevertheless a "predicate to an intelligent resolution" of questions before it. *See Vance v. Terrazas*, 444 U.S. 252, 258-59 n.5 (1980). *See also Ohio v. Robinette*, 117 S. Ct. 417, 420 (1996); *Caterpillar, Inc. v. Lewis*, 117 S. Ct. 467, 476 n.13 (1996). Here, the legitimacy of the possession-of-the-invention requirement is both an issue "antecedent to . . . and ultimately dispositive of" the dispute about the standards to be applied to the requirement and a "predicate to an intelligent resolution" of that dispute.

Respondent further argues that "the Federal Circuit should have been given the first opportunity to address the question . . . ." Br. in Opp. 15. But that argument disregards the obvious fact that the Federal Circuit has squarely addressed the question and made clear its view. Eight years ago, in *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991), the court sought to eliminate "some confusion in our decisions" (*id.* at 1563) by ex-

pressly reaffirming the existence of a second written description requirement. *Id.*[1] The Federal Circuit subsequently has applied that requirement without further circumspection, including in the present case. It would thus be an empty formalism to require litigants before the Federal Circuit to express repeated disagreement with a requirement that the court has recently reconsidered and unequivocally reembraced. It is review by this Court, not further review by the Federal Circuit, that is needed.

2. We argued in the petition that the second written description requirement (showing possession of the invention) serves no legitimate purpose not already served by the traditional written description requirement (enabling the making and using of the invention). As we there indicated, the problem is not with the general notion that an inventor must show possession of his invention; rather, the problem is with the idea that a description sufficient for enablement is nonetheless not sufficient to show possession. By insisting on a requirement "separate and distinct from the enablement requirement," *Vas-Cath*, 935 F.2d at 1563, the Federal Circuit has simply created a standardless, and often arbitrary, impediment for inventors, which serves to deprive them of patents to which (under a proper reading of Section 112, ¶ 1) they are rightfully entitled.

Respondent tries to answer this argument by putting forth his own explanation for a second written description requirement: "the need to show that an invention (*i.e.*, something distinct from the prior art) is disclosed by the application . . . ." Br. in Opp. 18. This theory, however, simply confirms how much confusion can be engendered

[1] The admission by the Federal Circuit of "confusion in [its] decisions" belies respondent's assertion that the second written description requirement has a "long history of consistent application." Br. in Opp. 21 n.11; *see also* Br. in Opp. 17 ("consistently applied"). For the same reason, there is nothing to the point that Congress implicitly ratified the requirement, during the period of confusion, by amending Sections 120 and 112 of the Act. *See* Br. in Opp. 22-23.

by a second, non-statutory written description requirement. Most obviously, the justification offered by respondent has nothing whatsoever to do with the justification offered by the Federal Circuit: "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996) (internal quotes omitted). (In our view, of course, that purpose of the requirement is served by an enabling description without more.) Indeed, the explanation given by respondent seems to have nothing to do with the concept of demonstrating "possession of the invention"—which, after all, assumes that there is an invention—but rather with the concept of identifying an invention to be possessed.

The theory presented by respondent also goes against settled understandings under the patent laws. According to respondent, it is the written description in a specification, not the patent claims themselves, that must carry out "the function of distinguishing an invention from the prior art . . . ." Br. in Opp. 18. But respondent has matters just backwards. It is the *claims*, not the written description, that "define the invention for the purpose of applying the conditions of patentability (eligible subject matter, originality, novelty, utility, and nonobviousness), the statutory bars, and the disclosure requirement." D. Chisum, 3 *Patents* § 8.01 at 8-3 (1998 ed.). *See* 35 U.S.C. § 112, ¶ 2 (claims must specify what "the applicant regards as his invention"). This Court has so stated, in fact, observing that, in applying the Section 103 standard of nonobviousness, it is necessary to determine the "differences between the prior art *and the claims at issue*." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (emphasis added). *See generally Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1388 (1996) ("[t]he claim define[s] the scope of a patent grant") (internal quotes omitted); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 117 S. Ct. 1040, 1049 (1997) (noting "definitional and public-notice functions of the statutory claiming require-

ment"). Each *claim* must define an invention that is distinguishable from the prior art, while the written description in the specification must enable the making and using of the invention defined in the claim.

Respondent compounds his mistake by asserting that "historically, a major function of the written-description requirement has been to 'distinguish [the invention] *from all other things before known.*' " Br. in Opp. 19 (quoting Patent Act of 1793 § 3, 1 Stat. 318) (emphasis added by respondent). As we noted in the petition, however, the requirement that the written description distinguish the invention "from all other things before known" was dropped from the Patent Act in 1836, at the time that the Act first required the inventor to specify the subject matter of his invention. (The 1870 Act subsequently required an inventor to "claim" his invention.) From that point on, the purpose of the written description requirement was simply to provide a written description of the invention, along with the manner of making and using it, that was sufficient to allow a person skilled in the art to make and use it. The belated efforts by respondent to engraft an additional requirement are thus no more supportable than the efforts by the Federal Circuit.

Respondent asserts, however, that our reading of the statute makes the parenthetical phrase "and of the manner and process of making and using it" into mere surplusage. To begin with, this assertion is dubious: it seems entirely natural for Congress to require an inventor to describe both the end product of his work ("the invention") and the steps necessary to create and employ it ("the manner and process of making and using it") in such terms as to allow a skilled artisan to make and use it. Indeed, if the inventor were not required to describe the manner of making and using the invention, it might be argued that he had satisfied his obligation under Section 112, ¶ 1 merely by describing the invention itself and forcing the artisan to undertake the possible but burdensome task of working backwards to determine the manner of making it. In

any event, however, even if there were some unnecessary wording, it is far more reasonable to think that Congress engaged in the not uncommon practice of repeating itself than to assume that Congress consciously intended the modifying language following the parenthetical to apply *only* to it, and not to the words "the invention." There is no known grammatical construction that can lead to that illogical result.[2]

3. The attempt by respondent to minimize the significance of *Pfaff* is also unavailing. In essence, respondent argues that the decision in *Pfaff* sheds no light on the issue here because neither the on-sale bar nor the "ready for patenting" standard in that case has anything to do with "distinctions over prior art" (Br. in Opp. 22) or "advancing the prior art" (Br. in Opp. 22). The short answer to this argument is that the written description requirement likewise is not concerned with distinctions over prior art. *See* pages 5-6 *supra*. More significant, however, is the light that *Pfaff* does shed on a central question in this case: when an inventor may be regarded as having a complete conception of his invention.

On that point *Pfaff* has much of importance to say. In particular, the Court in *Pfaff* observed that "[t]he word 'invention' must refer to a concept that is complete, rather

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[2] Respondent does little to defend the holding below that the written description must "necssarily" or "unambiguously" show possession of the invention (assuming that the "possession" requirement is valid). Although he says that this standard is "more precise" than the "reasonably conveys" standard, there is nothing more exact or easier to apply about the "necessarily" standard; it is simply narrower. And, in arguing that the "necessarily" standard would not resolve all doubts against the inventor, as its terms would suggest, respondent offers the reassurance that "as long as the inventor, expert in his or her own field, would fully and accurately describe the invention, the disclosure would *likely* be found sufficient." Br. in Opp. 14 n.7 (emphasis added). This case is a perfect example of the uncertainty caused by a requirement that a "full[]" and "accurate[]" description of the invention would likely, but not necessarily, be enough to satisfy.

than merely one that is 'substantially complete.'" 119 S. Ct. at 311. The Court then noted that, while reduction to practice is typically "the best evidence that an invention is complete," *id.*, it is not the only possible evidence: "one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice." *Id.* Finally, the Court held that—to prove that an invention is ready for patenting—it would be sufficient that "the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 312.[3] Taken together, these observations plainly lead to the conclusion that a description enabling the making and using of an invention also establishes that the inventor has a complete conception of his invention.

That is precisely the point that we are making here: that an inventor providing an enabling description of his invention is properly deemed to be in possession of the invention at that time. That being so, it is wholly anomalous for the Federal Circuit to hold that an inventor must meet *both* an enablement requirement *and* a "separate and distinct" possession-of-the-invention requirement (which is not satisfied by proof of enablement). It is this second requirement, ungrounded in the statute, that confronts patent applicants with the task of drafting specifications to satisfy a largely standardless inquiry and leads to the sort of *ad hoc* judgments admitted by respondent to be part and parcel of the possession-of-the-invention legacy. *See* Br. in

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[3] The Court said that the condition (that "the invention must be ready for patenting," 119 S. Ct. at 312) "may be satisfied in at least two ways." *Id.* Respondent now argues (Br. in Opp. 22) that use of the term "may be satisfied" indicates that the condition might *not* be satisfied in the specified ways. This fanciful reading is contradicted by the very next sentence in *Pfaff*, which states that the condition had been met in that case "because the drawings Pfaff sent to the manufacturer before the critical date fully disclosed the invention." *Id.* By the same token, a full, enabling disclosure is enough to satisfy the written description requirement of Section 112, ¶ 1.

Opp. 24. The law thus should be clarified to make clear that proof of enablement alone is enough to satisfy the written description obligations of Section 112, ¶ 1.

4. In order to diminish the importance of this case, respondent claims that it "involve[s] substantial, dispositive factual findings by the Board . . . ." Br. in Opp. 23. But the only "dispositive" findings of the Board were directed to the wrong question: whether, in addition to showing enablement, petitioner had demonstrated possession of the invention. If a showing of enablement is enough to satisfy Section 112, ¶ 1—as we contend that it is (along, of course, with a disclosure of the "best mode")—then the findings of the Board with respect to the erroneous additional requirement are wholly beside the point.[4]

Respondent also suggests that petitioner may be estopped from demonstrating that his written description enabled the making and using of a single chip computer. But this argument is a red herring. The Patent and Trademark Office, in issuing his patent, necessarily accepted that the written description submitted by petitioner did enable the making and using of a single chip computer, and the Board *rejected* the argument that an earlier decision estopped petitioner from demonstrating that this conclusion was correct.[5] Although reversal of the decision

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[4] On one factual point, we note that, while respondent asserts that petitioner's 1977 application included a more comprehensive description of a single chip computer than Claim 40 in the 1970 application, the language is, in fact, conspicuously similar. Compare Br. in Opp. 5 (quoting Claim 40) with Br. in Opp. 7-8 (quoting 1977 application). It is undisputed that the 1977 language met the written description requirement, even as applied by the Federal Circuit.

[5] Although respondent twice seeks to obscure the fact, *see* Br. in Opp. 12 n.6 ("Board . . . did not reach a consensus"); Br. in Opp. 25 ("decision . . . which divided the Board"), the Board held, by a 2-1 majority, that petitioner was not estopped by an earlier decision, *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (un-

below will not assure that petitioner will ultimately prevail, it will assure that his right to a patent is not defeated, as it currently has been, on grounds that Congress did not provide for in the statute.

This case is thus of considerable importance. There is no reason to force patent applicants to satisfy a newly-invented requirement for patentability that has no legitimate statutory moorings and no sufficient, or even discernible, justification. The possession-of-the-invention requirement imposed by the Federal Circuit is just such a requirement, and it should not be allowed to stand without review by this Court.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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published opinion), from establishing enablement before the Patent and Trademark Office. Pet. App. 40a-50a.